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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,494	01/24/2002	Noam Livnat	2000.129000/TT5979	2284
23720	7590	10/04/2006	EXAMINER	
WILLIAMS, MORGAN & AMERSON 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			GOLD, AVI M	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,494

Applicant(s)

LIVNAT ET AL.

Examiner

Avi Gold

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the amendment filed on July 13, 2006. Claims 1-10 are pending.

Response to Amendment

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being unpatentable over Ishii, U.S. Patent No. 6,594,505, further in view of Mohammed, U.S. Patent No. 6,647,426.

Ishii teaches the invention substantially as claimed including a mobile telephone system capable of coping with a variety of mobile radio telephone systems by a single mobile radio telephone (see abstract).

Regarding claim 1, Ishii teaches a method for delivering a communication protocol to an electronic device, comprising:

a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, the plurality of communication protocols including the first communication protocol and a second communication protocol (col. 2,

lines 27-51, Ishii discloses mobile radio telephones with mobile base stations connected to one another with possible different communication protocols);

establishing communication between the first and second devices using the first communication protocol (col. 2, lines 39-42, Ishii discloses mobile radio telephone communication over a protocol);

transferring the second communication protocol from the second device to the first device (col. 2, lines 43-48, Ishii discloses downloading of a protocol software from one base station to the other);

installing the second communication protocol on the first device; and switching to the second communication protocol for further communication (col. 2, lines 43-51, Ishii discloses executed communication on the new protocol after the download is completed).

Ishii fails to teach the limitation further including the physically attaching the devices.

However, Mohammed teaches a technique for seamlessly integrating voice and data telecommunication services across a licensed wireless system and an unlicensed wireless system (see abstract). Mohammad teaches the use of a connected desktop phone and base station (col. 16, line 61 – col. 17, line 14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ishii in view of Mohammed to physically attach devices. One would be motivated to do so because it allows for a better connection.

Regarding claim 2, Ishii teaches the method of claim 1 wherein the first and second communication protocol are software communication protocols (col. 2, lines 43-48).

Regarding claim 3, Ishii teaches the method of claim 1 wherein the first and second electronic devices are handheld devices (col. 2, lines 27-51).

Regarding claim 4, Ishii teaches the method of claim 1 wherein the established communication is point-to-point communication (col. 2, lines 27-51).

Regarding claim 5, Ishii teaches a method for exchanging data between electronic devices, comprising:

a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, the plurality of communication protocols including the first communication protocol and a second communication protocol;

determining that the second communication protocol is not installed on the second device;

based on this determination, selecting the first communication protocol from the plurality of communication protocols; and

establishing communication between the first and second devices using the first communication protocol (col. 2, lines 27-51).

Ishii fails to teach the limitation further including the physically attaching the devices.

However, Mohammad teaches the use of a connected desktop phone and base station (col. 16, line 61 – col. 17, line 14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ishii in view of Mohammed to physically attach devices. One would be motivated to do so because it allows for a better connection.

Regarding claim 6, Ishii teaches the method of claim 5 further comprising:
transferring the second communication protocol from the second device to the first device;
installing the second communication protocol on the first device; and
switching to the second communication protocol for further communication (col. 2, lines 27-51).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishii, U.S. Patent No. 6,594,505.

Ishii teaches the invention as claimed including a mobile telephone system capable of coping with a variety of mobile radio telephone systems by a single mobile radio telephone (see abstract).

Regarding claim 7, Ishii teaches an apparatus for delivering data to a handheld electronic device, the apparatus comprising:

non-volatile storage for storing a plurality of communication protocols including a first communication protocol and a second communication protocol; and

a processor configured to: establish communication with the handheld device using the first communication protocol; transfer the second communication protocol to the handheld device;

install the second communication protocol on the handheld device; and

switch to the second communication protocol for further communication with the handheld device (col. 2, lines 27-51).

Regarding claim 8, Ishii teaches the apparatus of claim 7 further comprising an electrical connector physically coupling the apparatus to the handheld device (col. 2, lines 27-51).

Regarding claim 9, Ishii teaches the apparatus of claim 7 wherein the first and second communication protocol are software communication protocols (col. 2, lines 43-48).

Regarding claim 10, Ishii teaches the apparatus of claim 7 wherein the established communication is point-to-point communication (col. 2, lines 27-51).

Response to Arguments

5. Applicant's arguments filed July 13, 2006 have been fully considered but they are not persuasive.

6. In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., physically attaching a device in claim 7) is not recited in the rejected claim.

Although the claim is interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art.

8. In response to applicant's argument that Mohammed is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both pieces of art are related to wireless communications systems.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,141,690 to Weiman

U.S. Pat. No. 5,349,649 to Iijima

U.S. Pat. No. 6,738,815 to Willis, Jr. et al.

U.S. Pat. No. 6,098,138 to Martinelli et al.

U.S. Pat. No. 5,696,903 to Mahany


U.S. Pat. No. 5,287,541 to Davis et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold
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